

Remarks

Reconsideration of this Application is respectfully requested.

Claim 1 has been amended. Claims 1-39 are pending in the application.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections.

Claim Objections

Claim 1 was objected to because it did not contain a step "(a)". This rejection has been rendered moot due to the amendment of the claim to include step (a).

Claim Rejections Under 35 U.S.C. § 103

Claims 1-22 and 24-39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Blevins (WO 98/26872) in view of Novotny, et al. (5,453,382), and certain Stratagene and GIBCO advertisements.

Establishing *prima facie* obviousness requires a showing that each claim element is taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Absent a showing of such motivation and suggestion, *prima facie* obviousness is not established. *See In re Fine*, 5 USPQ2d at 1598.

Claims 1-22 and 24-39 recite methods for extracting nucleic acids from a sample.

Blevins and Novotny do not disclose methods for extracting nucleic acids. Rather, these references demonstrate the separation of non-analogous small molecule analytes (e.g., dye in Blevins' example 1 and drugs in Blevins' example 2, and cimetidine and ranitidine in Novotny example 1). To be properly relied upon as reference under 35 U.S.C. § 103, a reference must be

analogous to the claimed invention (see MPEP 2141.01(a)). "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). The separation of the small molecule drug and dye analytes is not in the field of applicant's invention, and is not at all pertinent to the separation of nucleic acids. Therefore, neither Blevins nor Novotny qualify as proper § 103 references. Persons of skill in the nucleic acid separation art simply would not have been motivated to use the small molecule analyte methods of Blevins and Novotny to solve the problem of nucleic acid separation with which the present inventors were concerned.

In view of the foregoing remarks, Applicants respectfully submit that the disclosures of Blevins, Novotny, Statagene, and GIBCO, alone or in combination, do not establish a prima facie case of obviousness. Therefore, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,



Natalie A. Davis
Patent Agent
Invitrogen Corporation
Registration. No. 53,849

Date: February 21, 2006